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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,784	02/12/2004	Takuya Shiraishi	10449-075001 / PIS2003327	5416
26161	7590	10/23/2006	EXAMINER PSITOS, ARISTOTELIS M	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT 2627	PAPER NUMBER

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/777,784	Applicant(s) SHIRAISHI ET AL.	
	Examiner Aristotelis M. Psitos	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/10/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

In response to applicants' representatives phone call of 10/10/06, the previous OA is vacated and the subsequent OA takes its place. The period to respond commences with the mailing of this OA.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The IDS filed has been received and made of record.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 15,7-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiraishi et al – ('257).

The applied reference has a common assignee/inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Applicants' attention is drawn to figure 3, the elements of independent claims 1 and 15 are self-evident and no further analysis is made.

With respect to claims 2,4,5,7,8 and 9 – elements 16,17,27, and 18 meet claims 3 and 5 and the operation/functional limitations of claims 4,7,8 and 9.

With respect to claim 3, element 19 meets this claim.

With respect to claims 10,11,12,13, see figure 6 and its description.

With respect to claim 4, this describes the formats as disclosed in Shiraishi et al and hence inherently present.

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2. Claim 6 is rejected under 35 U.S.C. 103(a) as being obvious over the art as applied against the claims as stated in paragraph 1 and further considered with Sugiyama et al.

With respect to the limitation of claim 6, such is discussed in the Sugiyama et al, see col. 5 lines 18 plus for instance with respect to the write strategy circuitry and registers therefore.

It would have been obvious to modify the base system as relied upon above in paragraph 1 with the above additional teaching from Miyagawa et al, motivation is as discussed in Sugiyama et al.

3. Claims 1 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Hwang et al further considered with Kamatani and Mashimo.

Hwang et al discloses a multi-format recording system – see col. 2 starting at line 22. Such is appropriately selected and such along with information identifying such is recorded on the disc – see col. 2 lines 27-31.

There is no clear depiction of the plurality of address decoders and appropriate selection of such predicated upon format/disc type.

As further taught by both Mashimo and Kamatani, the use of encoders/decoders for identification of type of information as well as position information thereof – is well known – see in Mashimo for instance the disclosure with respect to elements 34,40 – as well as col. 1 lines 15 plus and in Kamatani the flow chart of figure 3 and its related disclosure, as well as col. 1 starting at line 39.

It would have been obvious to modify the base system of Hwang et al with the above teachings from both Kamatani and Mashimo, so as to provide the appropriate encoders/decoders and increase the flexibility of the base system.

4. Claims 2-5 and 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 and 15 as stated in paragraph 3 above, and further in view of the acknowledged prior art/figure 1 of Shiraishi et al ('257). The elements recited herein find clear correspondence in the acknowledged prior art of figure 1 in Shiraishi et al – applicants' cooperation in further identifying such is respectfully required to complete the search report.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 5 as stated in paragraph 4 above, and further in view of Sugiyama et al.

With respect to the limitation of claim 6, such is discussed in the Sugiyama et al system; see for instance starting at col. 5 line 18 (plus) – with respect to the write pulse strategy and use of registers.

It would have been obvious to modify the base system as relied upon above in paragraph 4 with the above additional teaching from Miyagawa et al, motivation is as discussed in Sugiyama et al.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 as stated in paragraph 3 above, and further in view of Ito.

The formats described are known in this environment as further taught by Ito.

It would have been obvious to modify the base system of as relied upon in paragraph 3 above with this additional teaching, motivation is to increase the flexibility of the base system so as to record these types of formats.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos
Primary Examiner
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A handwritten signature in black ink, appearing to be 'APsitos', written over the printed name of the examiner.

AMP